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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,235	05/29/2001	Larry Richard Robinson	8569	5928

27752 7590 12/14/2004

THE PROCTER & GAMBLE COMPANY  
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CINCINNATI, OH 45224

EXAMINER

HUI, SAN MING R

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/867,235	<b>Applicant(s)</b> ROBINSON ET AL.	
	<b>Examiner</b> San-ming Hui	<b>Art Unit</b> 1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's amendments filed September 20, 2004 have been entered.

Claims 27-31 are pending.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Rouquet et al. (EP 0908175) as evidenced by Stedman's and Mosby's Medical Dictionary.

Rouquet et al. disclose stable topical compositions containing solid elastomeric organopolysiloxane and spherical particles. Exemplified is a water-in-oil make-up foundation comprising, dimethicone copolyol (silicone oil), cyclomethicone (silicone oil), octyl methoxycinnamate (oil-soluble sunscreen anti-inflammatory agent), and KSG-16 (crosslinked silicone elastomer), wherein foundations are applied to the skin. Thus, Rouquet et al. and the instant invention both teach a method of applying to the skin a composition comprising a water-in-oil emulsion comprising a silicone oil, a crosslinked silicone elastomer, and a skin care active, all of which are in the oil-phase. See pages 10-11.

Stedman's Medical Dictionary, 27<sup>th</sup> Edition defines a sunscreen that protects the skin from ultraviolet induced erythema and Mosby's Medical Dictionary, 4<sup>th</sup> Edition defines erythema as redness or inflammation of the skin or mucous membranes.

The claims are directed to a method of applying a composition comprising oil-soluble skin care active, silicone oil, and silicone elastomer to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. *In re Spada*, 91 1 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 199%). See MPEP 2112.01). The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components' as instantly claimed, which would inherently enhance the delivery of the oil soluble skin care active and regulate the condition of the skin and enhance the delivery of the same, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

### ***Response to Arguments***

Applicant's arguments filed September 20, 2004 averring the presence of the unexpected results as demonstrated in declaration filed September 20, 2004 have been considered, but are not found persuasive. Examiner notes that the outstanding

rejection is an anticipation rejection. Therefore, unexpected results will not be sufficient to obviate anticipation rejection.

Applicant's arguments filed September 20, 2004 averring the narrower scope of the claims, taken with the unexpected results obviating the outstanding rejection have been considered, but are not found persuasive. Even though the claims recite "consisting essentially of", the outstanding rejection would still be proper because the phrase "consisting essentially of" is construed as "comprising" when searching and applying prior art, absent showing the additional agents as changing the basic and novel characteristics of the invention. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristic of the claimed invention. For the purpose of searching for and applying prior art under 35 USC 102 and 103, absent clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. ("PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*,

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12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989)(“Although consisting essentially of” is typically used and defined in the context of compositions of matter, we find nothing intrinsically wrong with the use of such language as a modifier of method steps. . . [rendering] the claim open only for the inclusion of steps which do not materially affect the basic and novel characteristics of the claimed method. To determine the steps included versus excluded the claim must be read in light of the specification. . . . [I]t is an applicant’s burden to establish that a step practiced in a prior art method is excluded from his claims by ‘consisting essentially of’ language.”) (See MPEP 2111.03).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (571) 272-0626. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
San-ming Hui  
Primary Examiner  
Art Unit 1617